



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,868	07/17/2000	Thomas J. Shaw	75329 77432	8293

20873 7590 10/19/2006

LOCKE LIDDELL & SAPP LLP  
ATTN: DOCKETING DEPT.  
2200 ROSS AVENUE  
SUITE 2200  
DALLAS, TX 75201-6776

EXAMINER
----------

HAN, MARK K

ART UNIT	PAPER NUMBER
----------	--------------

3767

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/617,868

Applicant(s)

SHAW, THOMAS J.

Examiner

Mark K. Han

Art Unit

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 29-34,36-42,44-50,52,54-94 and 96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-34,36-42,44-50,52,54,55,58-94 and 96 is/are allowed.
- 6) ☒ Claim(s) 56 and 57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,019,044 to Tsao (as cited by Applicant) in view of U.S. Patent No. 5,304,138 to Mercado (as cited by Applicant).

Tsao discloses a syringe having a hollow syringe body 12, retractable needle 30, continuous retaining member 26, plunger 50, plunger seal 60, a structure in the front end portion 18 and plunger tip 51. See Figures 1-4. Tsao, however, does not disclose that the outer periphery of the plunger end cap to be receivable into the opening of the back end of the syringe body upon retraction. Mercado discloses a syringe having a plunger 22 having an outer periphery 24 such that upon completion of the delivery stroke, the outer periphery sits within the body of the syringe. This discourages anyone from reusing the syringe. See Figure 1. See also col. 1, lines 40-54 and col. 2, lines 25-39. It would have been obvious to one of ordinary skill in the art to modify the invention of Tsao, by having the outer periphery of the plunger to sit within the body of the syringe, as suggested by Mercado, in order to prevent reuse of the syringe and the spread of disease from the use of a contaminated syringe.

*Allowable Subject Matter*

2. Claims 29-34, 36-42, 44-50, 52, 54, 55, 58-94 and 96 are allowed.

*Response to Arguments*

3. Applicant's arguments filed 17 August 2006 have been fully considered but they are not persuasive.

Applicant first argues that the Tsao device is inoperative. See Remarks, p. 27, line 23 through p. 28, line 10. It is considered that inoperativeness of a prior device does not render it as unavailable for prior art purposes. Therefore, the Tsao reference will be used as valid prior art.

Applicant secondly argues that the combination of Mercado and Tsao would be inoperative. Applicant uses elements of Mercado that the Examiner does not consider in the rejection of the claims. See Remarks, p. 28, line 20 through p. 29, line 11. The entire teachings of one reference does not need to be incorporated into another reference under a 35 U.S.C. §103(a) analysis.

The rejection under 35 U.S.C. §103(a) is hereby maintained.

*Conclusion*

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 3767

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark K. Han whose telephone number is 571-272-4958. The examiner can normally be reached on Monday to Friday, 9 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3767

*mkh.*

Mark K. Han  
Patent Examiner  
Art Unit 3767

mkh

October 16, 2006

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

*Kevin C. Sirmons*